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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/882,197

Filing Date: June 25, 1997

Appellant(s): GREER ET AL.

Eric T. King (Reg. No. 44,188)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 28, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,279,112	O'TOOLE et al.	8-2001
5,796,952	DAVIS et al.	8-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole, Jr. et al. (U.S. Patent No. 6,279,112 B1) in view of Davis et al. (U.S. Patent No. 5,796,952). This rejection is set forth in a prior Office Action, mailed on October 29, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole, Jr. et al. (U.S. Patent No. 6,279,112 B1) in view of Davis et al. (U.S. Patent No. 5,796,952).

O'Toole discloses a system comprising:

[Claim 3] a target computer to receive a content including an advertisement (Figs. 1, 3 – The client computer is the target computer; col. 10, lines 18-21); and

a content provider coupled to the target computer via a network to transmit the content (Figs. 1, 3 – The servers are content providers), the content provider comprising:

a user rule page containing information automatically obtained from the target computer by a first agent, the first agent having a triggering program to filter information and to determine whether the information is relevant to the user rule page (col. 7, line

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24 through col. 8, line 4 – The smart digital offer object functions as the claimed “first agent.” Profile information, i.e., “a user rule page,” received from the client computer is sent to trusted servers. This profile information is information requested by, i.e., information deemed significant to, the trusted servers; therefore, O’Toole’s smart digital offer object functions as the claimed “first agent having a triggering program to filter information and to determine whether the information is significant”), the user rule page including at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer (col. 7, lines 38-43; col. 8, lines 1-4; col. 9, lines 18-28 – O’Toole’s smart digital offer object may track “dynamic information related to a user using the target computer,” such as the user’s purchasing history); and

a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer, the rule stored in form of a condition-action pair (col. 10, lines 18-24 – Customizing “client-specific sales offers and coupons” sent by a server to a client computer based on the profile received from the client computer is by definition controlled by a set of rules. This is how the server automatically determines which offers and coupons to send to which client. Further, all decisions made in a computer system are based on condition pairs. For example, if A is true, then perform B. If the client has a history of purchasing computer parts, send him/her an advertisement and/or coupon to purchase a DVD drive. O’Toole’s collection

of rules for customizing targeted information based on a client's profile is equivalent to the claimed "rulebook...based on the user rule page");

wherein a second agent updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page and finds new appropriate content including a second advertisement that is transmitted to the target computer (col. 7, lines 24-43 – A smart digital offer object is retrieved with each "document of web-based information" and each additional object can update the user's profile, i.e., "user rule page"; col. 10, lines 18-21);

[Claim 5] wherein the first agent uses an internet programming language (col. 7, lines 26-29 – O'Toole's smart digital offer object may be programmed as an Active X applet. Active X is known in the art to be useful for developing interactive content for the World Wide Web, i.e., the internet);

[Claim 41] wherein the content is transmitted in an internet protocol format (col. 10, lines 18-21);

[Claim 46] wherein the first agent is an object code for a control residing on a web page (col. 7, lines 24-43 -- A smart digital offer object, e.g., written in Active X, is retrieved with each "document of web-based information" and then activated at the client computer);

[Claim 47] wherein the control is transmitted with the web page while a dormant object resides on a server (col. 7, lines 24-43 -- A smart digital offer object, e.g., written in Active X, remains dormant on the server until it is retrieved with a "document of web-based information" and then activated at the client computer);

[Claim 48] wherein the target computer communicates with additional content providers, and wherein the target computer maintains several provider rule pages of the additional content providers (col. 7, lines 22-62 – The “additional content providers” are equivalent to O’Toole’s multiple trusted servers, each of which is separately authorized by the client’s avatar to have access to requested client information, which is then used to create a respective user profile, i.e., “rule page,” stored by each of the authorized trusted servers);

[Claim 49] wherein each provider rule page includes information from at least one of the additional content providers (col. 7, lines 22-62 – The “additional content providers” are equivalent to O’Toole’s multiple trusted servers, each of which is separately authorized by the client’s avatar to have access to requested client information, which is then used to create a respective user profile, i.e., “rule page,” stored by each of the authorized trusted servers).

Regarding claims 3, 4, 24, 25, and 28, O’Toole discloses the use of a “channel object” to set up an asynchronous communication service for providing information to a client computer via a broadcast, satellite feed, internet, cable, or multicast channel (col. 4, lines 20-50; col. 5, lines 4-22; col. 6, lines 32-39). In order to successfully set up a communication channel between a client and server, the two must be utilizing hardware and software compatible with the particular type of communication used (e.g., broadcast, satellite feed, internet, cable, or multicast channel). O’Toole does not explicitly disclose how this confirmation of compatibility between the client and server’s

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communication hardware and software is established; however, Davis teaches the monitoring of client activity in order to create a client profile that is used to target content, such as an ad, to a user (col. 4, lines 24-27). More specifically, Davis discloses a tracking system that comprises agents, such as JAVA applets or those written in Active X, in order to profile user information (col. 10, lines 50-57). Davis states that the following types of information can be obtained from a client computer:

...When the client leaves the Web page (S307), the tracking program calculates the amount of time the user has interacted with and displayed the Web page and sends this information to a server. Other available client information, such as the network ID and client ID, or so-called 'Cookie' of the client, is also sent to the server (S308). If desired, other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer. (Col. 9, lines 35-45)

Davis teaches the ability to use an agent to obtain data regarding hardware characteristics of a target computer (as per claim 3). Further, Official Notice is taken that it is old and well-known in the art of computers that modem speed, processor type, amount of memory available, processor clock speed, and computer memory usage are commonly used to define the hardware characteristics of a computer (as per claims 4 and 24). Also, Official Notice is taken that it is old and well-known in the art of computers to assess the software profile, including data regarding a software package and memory usage, of a computer (as per claim 25). All of this information regarding hardware and software characteristics of a computer is important when deciding which communication protocols to establish, especially when compatibility of communication

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protocols between a server and client is being assessed (as would be important to O'Toole for the reasons discussed above). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with O'Toole a condition in the condition-action pair being a hardware characteristic, including modem speed, processor type, amount of memory available, processor clock speed, and computer memory usage, of the target computer to then use the rule to match content with the hardware characteristics of the target computer (as per claims 3, 4, 24, 28) and to incorporate with O'Toole the ability to gather software profile information, including that of a software package and memory usage of the target computer (as per claim 25) in order to help ensure that O'Toole's channel objects are transmitting content, such as advertisements, to client computers using both a communication protocol that is compatible with the server and respective client computer as well as an amount of information that can be handled by the respective client computer.

Further regarding claim 3, O'Toole does not explicitly teach the profiling of the web sites visited and time spent at each by a user; however, Davis makes up for this deficiency, as discussed above and in col. 9, lines 35-38 and col. 13, lines 47-62. Davis uses this information to more effectively "target an ad banner based upon the diverse interests of respective users" (col. 13, lines 60-62). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable O'Toole to profile information regarding the web sites visited and time spent at each by a user (as taught by Davis) in order to assist O'Toole

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in more effectively targeting content, such as advertisements, that may be of interest to each respective user.

[Claim 29] O'Toole teaches the transmission of advertisements to client computers (col. 10, lines 18-21); however, he fails to explicitly disclose that the advertisements may be advertisement banners *per se*. Davis discloses the targeting of advertisement banners based on a user's profile (col. 13, lines 57-62). Advertisement banners typically span a web page and are therefore especially useful in drawing a customer's attention to an ad. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt O'Toole to transmit targeted advertisement banners to its users (as taught by Davis) in order to provide web-based ads which are especially useful in drawing a user's attention to the advertised product or service, which is targeted to a user based on his/her profile.

[Claims 17, 18, 22, 23, 27, 32, 36, 40, 45, and 54-57] Claims 17, 18, 22, 23, 27, 32, 36, 40, 45, and 54-57 recite limitations already addressed by the rejection of claims 3-5, 24, 25, 28, 29, 41, and 46-49 above; therefore, the same rejection applies.

(11) Response to Argument

Appellant argues:

...O'Toole teaches an interactive smart digital offer object to allow the user to be interactively asked whether the user wishes to reveal certain user information and further to ask the user if the user wishes to accept an offer of a product or service, which the user can then interactively accept or decline. This is markedly different from Appellant's claimed invention of independent claims 3 and 17 related to a user rule page containing information automatically obtained from the target computer by a first agent having a triggering program to filter information and to determine whether the

information is relevant to a user rule page. (Page 8 of Appeal Brief)

As explained in the art rejection, O'Toole's smart digital offer object functions as the claimed "first agent." Profile information, i.e., "a user rule page," received from the client computer is sent to trusted servers. This profile information is information requested by, i.e., information deemed significant to, the trusted servers; therefore, O'Toole's smart digital offer object functions as the claimed "first agent having a triggering program to filter information and to determine whether the information is significant." (See at least col. 7, line 24 through col. 8, line 4.) O'Toole's user rule page is any profile information related to a user, especially that profile information that is useful in determining which offers are likely to be of interest to a user. For example, O'Toole's smart digital offer objects contribute to shaping the details of a offer based on a user's profile information, e.g., user rule page, as follows:

The terms or conditions of the offer, such as price and payment terms, are calculated by the smart digital offer object using formulas that depend on the information contained in the digital coupons and the other information examined by the smart digital offer object, including the time of day, or user profile information such as membership codes, user's age, user's income, and other demographic information certified by an independent authority with an authenticator. (col. 7, line 63 through col. 8, line 4)

Not only can offers be customized to a specific user's profile, but documents deemed to be of interest to a user can be customized based on the user's profile as well (col. 10, lines 4-24). By selecting and/or further customizing offers, documents, etc. to be delivered to a user based on the user's profile, it is clear that a smart digital object

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conforms to certain rules regarding how such customization (i.e., filtering of information) is to occur depending on profile details (i.e., a user rule page). If, on the other hand, the smart digital object did not filter information presented to a user, then the user would be bombarded with random offers, documents, etc. as opposed to ones that take into account details of the user's profile (as taught by O'Toole).

Appellant argues:

However, based on the sections of O'Toole cited by the Examiner, it is Appellant's opinion that O'Toole does not teach, suggest, or render obvious Appellant's detailed claim limitations related to *a rule book to provide a rule based on the user rule page...the rule controlling the content to be transmitted from a database to a target computer...the rule stored in the form of a condition/action pair...wherein the user rule page includes at least one of hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer including information on web-sites visited and time spent by the user on the web-sites*. These limitations are simply not taught or suggested by O'Toole. (Page 9 of Appeal Brief)

As explained in the art rejection, the act of customizing "client-specific sales offers and coupons" sent by a server to a client computer based on the profile received from the client computer is by definition controlled by a set of rules. This is how the server automatically determines which offers and coupons to send to which client. Further, all decisions made in a computer system are based on condition pairs. For example, if A is true, then perform B. If the client has a history of purchasing computer parts, send him/her an advertisement and/or coupon to purchase a DVD drive. O'Toole's collection of rules for customizing targeted information based on a client's

profile is equivalent to the claimed "rulebook...based on the user rule page." (See at least col. 10, lines 18-24.) Furthermore, independent claims 3 and 17 recite that the user rule page includes "at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer, the dynamic information including information on web sites visited and time spent by a user on the websites." The claim only requires that the user rule page recite one of the listed profile components. Nevertheless, the Examiner addressed all three limitations as if all three had been positively recited. However, these limitations were addressed by a combination of O'Toole, Davis, and various teachings of Official Notice, and not solely on the teachings of O'Toole. Appellant only addresses the individual teachings of each reference in a vacuum, thereby ignoring the rejection as a whole. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Additionally (in regards to the profiling of dynamic information related to a user), each time a server targets an offer to a user, the server sends along a smart digital offer object (col. 7, lines 24-26). A client "avatar" controls the release of the user's personal profile information to the server (col. 9, lines 22-61). This updated profile information is used by the server to target future offers to the user through smart digital offer objects

(col. 10, lines 18-28). Therefore, O'Toole teaches the use of various objects (including "avatars") to select and deliver offers of interest to a user and update a user's profile accordingly. Appellant argues that O'Toole, nevertheless, fails to address the claimed invention because "both the client avatar 210 and the client personal profile 206 are both located at the client computer not at a content provider." (Page 10 of Appeal Brief) The Examiner submits that the profile information released to and utilized by the smart digital offer objects to customize offers, information, etc. to a user are ultimately provided to the server, i.e., the content provider. The smart digital offer objects relay the released and updated profile information back to the offer-providing servers in order to assess the targeting of future offers (col. 7, line 24 through col. 8, line 4; col. 8, lines 58-65; col. 10, lines 4-24). After receiving user profile information at the server, the "server computer then transmits a client-specific sales offer of a customized document such as an electronic newspaper or magazine to the client computer based on the subset of the client personal profile received by the server computer." (col. 10, lines 12-16) Therefore, the Examiner submits that O'Toole's content provider, i.e., the server, does indeed comprise a user rule page (i.e., released profile information) and a rulebook (i.e., rules governing how to target content to a user based on his/her profile) in order to transmit customized content from the server computer to the client computer, as taught by O'Toole.

Appellant argues that there is no motivation to combine the teachings of Davis with those of O'Toole (Page 11 of Appeal Brief):

Thus, Davis is cited merely to teach the ability of an agent that can be used to obtain data regarding the

hardware characteristics of a target computer, and further to show that it has been known to track dynamic information including information on web-sites visited and time spent by the user on the web-sites. As the Examiner admits, Davis does not particularly teach or suggest a rule page including a software profile indicating software used by the target computer; but merely states that Official Notice is taken that it is old and well-known in the art of computers to access a software profile. (Page 11 of Appeal Brief).

Again, Appellant analyzes Davis in a vacuum, and not in light of the rejection over the combination of O'Toole, Davis, and Official Notice as a whole. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, the Examiner respectfully reminds Appellant that independent claims 3 and 17 recite that the user rule page includes "at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer, the dynamic information including information on web sites visited and time spent by a user on the websites." The claim only requires that the user rule page recite one of the listed profile components.

As explained above, the Examiner maintains that the combination of O'Toole, Davis, and the Official Notice statements address all of the claimed limitations, and, for the reasons presented in the art rejection, one of ordinary skill in the art at the time of Appellant's invention would have indeed found it obvious and been motivated to

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combine the teachings of O'Toole, Davis, and the Official Notice statements in order to yield the claimed invention.


For the above reasons, it is believed that the rejections should be sustained.

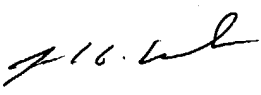
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